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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,784	01/02/2001	Marvin T. Ling	GTX-001 CIP2	1957
35023	7590	12/29/2004	EXAMINER	
LUCE, FORWARD, HAMILTON & SCRIPPS LLP 11988 EL CAMINO REAL, SUITE 200 SAN DIEGO, CA 92130			POINVIL, FRANTZY	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,784

Applicant(s)

LING, MARVIN T.

Examiner

Frantzy Poinvil

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/07/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-42 is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Remarks:

1. In the prior Office action, the Examiner has indicated that claims 30-42 were found to contain patentable subject matter because the prior art failed to teach or suggest:

“transferring compensation from the first member vendor to the second member vendor in an amount equal to the value of the electronic tokens of the second type taken in combination with a method of conducting electronic commerce as recited in independent claim 30”.

The applicant has now amended independent claim 1 to recite the electronic tokens are adapted to use for purchase from a plurality of other web servers “associated with a plurality of vendors, wherein the plurality of vendors accept at least one of the first type of electronic tokens and a second type of electronic tokens” and “for electronic transactions conducted at one of the plurality of vendors that accepts tokens of the second type, transferring compensation from the first web server to the vendor in an amount equal to the value of the electronic tokens of the second type”.

According to the language of claim 1, if a vendor accepts the second type of electronic tokens, a compensation from the first web server to the vendor in an amount equal to the value of the electronic tokens of the second type would not be possible or make sense since only “the second type” of tokens is being used during an electronic transaction. Also, it appears that using the first type of token is not required and no exchange of the electronic tokens is required or recited in the claim. Thus, when an electronic transaction is made, the vendor would not receive any compensation from the first web server since the first web server may not involve in the

transaction. Thus, claim 1 as amended does not differ in scope as originally presented, and therefore remains rejected as found in the prior Office action.

Claim 15 is currently amended in a similar manner as claim 1, and therefore remains rejected under a similar rationale.

The rejection of claims 1-29 is repeated below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 11, 14-21, 25 and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams et al. (US Patent No. 5,186,657).

As per claims 1 and 15, Williams et al. disclose all the claimed invention particularly a method for conducting electronic commerce comprising:

issuing a plurality of electronic tokens from a mall service provider server to a first web server, the electronic tokens adapted for use in electronic transactions for purchase or rental of products services from a plurality of other web servers; see the abstract and column 12, lines 9-19; maintaining a first database in the mall service provider server, the first database including account information for the first web server; (column 18, line 56 to column 19, line 3 and column 31, line 41 to column 34, line 2;

maintaining a second database in the mail service provider server comprising records of electronic transactions involving use of the electronic tokens at the plurality of other web servers (column 11, lines 53-63; column 18, line 56 to column 19, line 3 and column 31, line 41 to column 34, line 2);

and for each electronic transaction, recording a royalty transaction in the account information for web servers at which electronic transactions using the electronic tokens are conducted (column 17, lines 19-22 and column 19, lines 4-8).

As per claims 2 and 16, Williams et al disclose registering a plurality of users are registered with the first web server, each user having an account to which a subset of the plurality of electronic tokens are allotted. See column 18, line 56 to column 19, line 3 and column 12, lines 9-40.

As per claims 3 and 17, Williams et al disclose the first database further includes account information each one of the plurality of users. See column 36, line 63 to column 37, line 43.

As per claims 4 and 18, Williams et al disclose a subset of the plurality of tokens allotted to each one of the plurality of users based upon a purchase of electronic tokens at a predetermined rate of exchange by web Servers. See column 36, line 63 to column 37, line 43 and column 18, line 56 to column 19, line 3.

As per claims 5 and 19, Williams et al disclose the subset of the plurality of the plurality of users is provided as an incentive to reward customer loyalty. See column 19, lines 4-8 and column 17, lines 19-23.

As per claims 6 and 20, Williams et al disclose issuing electronic tokens from the mall service provider server to the first web server further comprises issuing manufacturer's tokens adapted for use only at predetermined ones the plurality of other web Servers. See column 10, line 42 to column 11, line 63.

As per claims 7 and 21, Williams et al disclose maintaining a service provider server that includes a listing of products and services that the manufacturer's tokens may be used to purchase or rent. See the abstract and column 11, lines 53-63.

As per claims 11 and 25, see figures 20 and 25 of Williams et al.

As per claims 14 and 28, Williams et al disclose maintaining the first database the mall service provider server further comprises maintaining a record indicating how many of plurality of electronic tokens are available for use. See column 34, lines 5-64.

As per claim 29, see column 11, lines 53-64 of Williams et al.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8,-10, 12,-13, 22- 24 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al (US Patent No. 5,815,657) view of Scroggie et al (US Patent No. 6,185,541).

The teachings of Williams et al are discussed above. As per claims 8, 9, 22 and 23, Williams et al do not explicitly teach reimbursing one plurality of other web servers for electronic tokens received during an electronic transaction and issuing a plurality of electronic tokens from the mall service provider server comprises issuing gift certificate tokens to the first web server. Scroggie discloses a system and method for providing shopping aids and incentives to customers through a computer network. In so doing, Scroggie discloses reimbursing electronic tokens during an electronic transaction. Note column 2, lines 52 to column 3, line 6. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Scroggie into Williams et al in order to encourage manufacturers and consumers to use the system thereby providing an attractive system.

As per claims 10, 12, 24 and 26, the combination of Williams and Scroggie teaches that a plurality of goods and services may be purchased using the electronic tokens. The type of

services or goods being purchased do not affect the functioning of the Williams et al or Scroggie as such would have been left to the user of the system of Williams et al and Scroggie.

As per claims 13 and 27, the combination of Williams et al and Scroggie discloses issuing a plurality of tokens to a plurality of different entities. The different entities being a vendor server that oversees electronic transactions using the first group of the electronic tokens through point sale terminals would have been obvious to one of ordinary skill in the art in order to reward the vendor server for their service in the overall system.

4. The prior art taken alone or in combination failed to teach or suggest transferring compensation from the first member vendor to the second member vendor in an amount equal to the value of the electronic tokens of the second type taken in combination with a method of conducting electronic commerce as recited in independent claim 30.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday-Thursday 7:00AM-5:30PM.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

FP

November 30, 2004


FRANTZY POINVIL
PATENT EXAMINER
AU 3628